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EXAMINER

FELTEN, DANIEL S

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3624

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/365,426
Filing Date: August 02, 1999
Appellant(s): HARTMAIER, PETER

Micheal J. Fogarty, III
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 03, 2005 appealing from the Office action
mailed May 18, 2005

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

WO98/34393	Hanson et al	8-1998
WO98/25237	Taskett	6-1998
WO97/04579	Taskett	2-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 1 12:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 29-34, 12-14 are rejected under 35 U.S.C. 1 12, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite the word, "substantially", one of ordinary skill in the art at the time of the invention would not be able to understand from the specification the metes and bounds of what this term means.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 12-14, 23, 29-32 and 34-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taskett (W0/25237, ¶T237" and W0 97/04579, ¶T579") in view of Hanson (WO 98/34393).

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T237 discloses,

As set forth in claims 29-32 and 34-40, a method of providing prepaid account services to consumers (see 1237, Abstract), assigning prepaid accounts to said consumers (see 1237, issuing a transaction card with an a unique authorization account code 142-- see 5g 2, Abstract and page 7, line 17 to at least page 8 , line 2),

--communicating with a service provider network/host computer regarding consumer replenishment transactions (see 1237, fig. 6, block 6lo--recharge account and block 610-- prompt selection from menu, also at least page 15, lines 5-6),

--wherein said communicating with the network step further comprises the steps of: receiving transaction messages following individual replenishment transactions by said consumers; and sending a message indicating the disbursement of funds associated with said replenishment transactions (6lo--prompt selection from menu---next appropriate action...indicates that the replenishment transaction has been made, also at least page 15, lines 5-6),

--communicating with a prepaid engine regarding said consumer replenishment transactions (see 7-237, fig. 7, Block 710-prompt caller to recharge account).

T237 fails to disclose,

--as set forth in claims 29-32, receiving a reconciliation message summarizing individual transactions that occurred during a certain period, and reconciling said individual transactions.

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T579 discloses,

receiving a reconciliation message (see 1579, at least page 4, lines 9-12 and lines 19-23). In view of the teaching of T579, it would have been obvious for an artisan of ordinary skill in the art at the time of the invention to employ the notoriously old and well known method of generating and transmitting summary transaction data, as taught by 1-579 into the 1237 system, because it would have been an obvious extension to the 1-237 teaching of checking the account balance of a calling card/transaction card, and/or regenerating a calling card/phone card account from the user menu options. The transaction summary data would provide the consumer with an obvious alternative method of checking the account balance or regeneration transaction by visually reviewing any kind of transaction data/history stored by the host computer/service provider network.

Thus such a modification would be an obvious expedient to one of ordinary skill in the art.

T237 fails to disclose,

as in claims 29-32, communicating with a service banking network/host computer regarding consumer replenishment transactions.

T579 teaches,

an Automated Teller Machine as a device in which to use the prepaid instrument/prepaid transaction card (see page 6, line 1 +). Since ATMS are conventionally associated with a

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banking/financial network, it would have been obvious for an artisan of ordinary skill at the time of the invention of 1-237 to substitute the ATM/financial network of T579 for the Service provider network of 1237 because an artisan at the time of the invention would recognize that the ATM/financial network would be a alternative source for financial data retrieval and replenishment, being an art recognized equivalent to the 1237 service provider network, inasmuch as financial data can be stored and retrieved from both devices. Thus such a modification would have been an obvious matter of design choice to one of ordinary skill in the art.

T237 fails to disclose,

associating said prepaid accounts with wireless telephones.

Hanson discloses,

Associating said prepaid accounts with wireless telephones (see Hanson page 3, lines 32+) since both 7-237 and 7-579 are associated with prepaid phone card accounts, it would have been obvious for an artisan of ordinary skill at the time of the inventions of 1237 and 7-579 to substitute the association of the wireless prepaid phone card account, as disclosed in Hanson, for the normal phone card account because an artisan at the time of the inventions would have recognized the modification/substitution of one account for the other as an art recognized equivalence inasmuch as both have similar uses to provide users with the ability to pay for calls (local or distant calls) via the provided system and thus an obvious expedient to one of ordinary skill in the art.

T237 fails to disclose

As in claims 23, 29, verifying location information associated with received transaction messages wherein said location identification information identifies authorized replenishment locations,' and processing replenishment transactions.

Hanson also discloses

As in claims 23 and 29, verifying location information associated with received transaction messages, wherein said location identification information identifies authorized replenishment locations (see Hanson Gg. 2, lines 22+). Since 1237 apparently is associated with adding funds to a prepaid remote account (see Abstract), an artisan would be motivated to identify authorized locations to replenish funds. Thus such modification of 1-237 by Hanson would be an obvious extension to the teachings of Hanson for customer's convenience.

T237 fails to disclose

As in claim, 30, verifying that permanent account numbers have been activated.

Re in claim 31

It is conventional in banking systems and other networking system that verification in the system to detect against transaction duplication that would be made if someone was going make a fraudulent or erroneous transaction. Therefore Official Notice is taken of transaction identifiers

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used for the purpose of determining if the transaction messages are not duplicates because such a notoriously old and well known practice would be an obvious extension to the aforementioned prior art to Thus to employ transaction identifiers associated with received transaction messages are not duplicates.

Hanson also discloses

As in claim 32, identifying transactions messages that are in variance with information contained in said reconciliation message and logging said identified transaction messages in an exception file (see Abstract; and page 6, lines 31+). It would have been obvious for one of ordinary skill in the art to provide a file history (or log), because such a modification would allow the system to track large amounts of information about various customers and keep proper records of the information. Thus such a modification would be an obvious expedient to one ordinary skill in the art.

(10) Response to Argument

I. Regarding the 35 USC § 112 Rejection

The specification discloses a reconciliation file that summarizes *all* transactions during the period (see specification page 16, lines 3-4), yet the applicant claims summarizing “substantially all” individual transactions that occurred during a certain period. It is not definite as to whether the applicant interprets “substantially all” in lieu of the specification; where the conjunctive phrase in this case may be interpreted as “partially” rather than totally as it is recited in the

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specification. Thus the phrase “substantially all” is considered indefinite and the 35 USC § 112 Rejection is maintained.

II. Regarding the 35 USC § 103(a) Rejection

All rejections from the previous office action are maintained.

Several of the independent claims require *sending a disbursement message to said bank wherein said disbursement message comprises information regarding the distribution of funds associated with said replacement transactions*” Taskett discloses an system for regenerating or adding funds to a prepaid card wherein one of the embodiments of the prepaid card is a debit card (see Taskett, WO 98/25237, Abstract, and page 12, line 15-16). It is asserted that it is inherent in the debit card embodiment of Taskett for communication to transpire between a financial institution (or funds source) and the prepaid card (or debit card) to acquire funds (see Taskett WO 98/25237, lines 22+).

In a broader sense, since applicant’s definition of a “bank” is “...*any system that supports a point of sale network*” (see specification page 9, lines 5+), the host computer 308 is interpreted as a bank, because the prepaid card balance is stored in the host computer (see Taskett, page 7, lines 2+). Thus the rejections are maintained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

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For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

Dan Felten



Conferees:

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